

REMARKS

The Office Action dated February 6, 1997 has been carefully reviewed . In response thereto, claims 56-88 have been amended. Claims 89-92 have been added. Claims 56-92 remain active in the application. Claims 67, 75, 80 and 84 stand objected to for various informalities. Claims 56-88 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 56-83 stand rejected under 35 U.S.C. § 102(b). Claim 75-79, 81, 83, 84-88 stand rejected under 35 U.S.C. § 103(a). Claims 56-88 are rejected under the judicially created doctrine of non-obviousness non-statutory double patenting and under the judicially created doctrine of double patenting.

The present application claims priority under 35 U.S.C. § 120 of the following applications:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Patent No.</u>
08/113,329	August 30, 1993	Pending
08/056,501	May 3, 1993	5,335,277
07/849,226	March 10, 1992	5,233,654
07/588,126	September 25, 1990	5,109,414
07/096,096	September 11, 1987	4,965,825
06/829,531	February 14, 1986	4,704,725
06/317,510	November 3, 1981	4,694,490

Consequently, Applicants will demonstrate disclosure only with respect to the '81 case, App. Ser. No. 06/317,510 and issued as U.S. Pat. No. 4,694,490.

Applicants have amended the pending claims in response to the Examiner's various rejections, objections and queries. Applicants believe that all pending claims clearly define the metes and bounds of the claimed subject matter, and are supported by an adequate written description that is fully enabling.

Claims 2-21 are rejected under 35 U.S.C. § 112, second paragraph, for being indefinite. Applicants respectfully submit that this rejection is traversed by the amendment which clarifies the claims in response to the Examiner's specific objections. The Office Action states that the "examiner is not certain that the meets [sic] and bounds of these claims can be determined because of the language in the disclosure and claims." It further states that "[a]pplicants are being requested to reference the claim limitations in this application to the disclosure so that the meets [sic] and bounds of these claims can be properly considered." Applicants traverse this rejection and submit they are under no duty to prospectively reference claim limitations to the specification where the Examiner has not specifically identified what is objected to as indefinite. MPEP § 2111 states that "[d]uring patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.'" Also, it is only "when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language." MPEP § 2111.01. Applicants respectfully request that this blanket rejection for indefiniteness be withdrawn.

However, in order to advance the prosecution of the present application, Applicants shall provide a summary of the pertinent disclosure including reference to examples supporting the claimed subject matter.

The disclosure of the '81 case is generally addressed to apparatus and methods for automatically controlling the transmission and presentation of information programming, including the application of embedded signaling for a number of

functions, including the control over decryption and access, monitoring of usage/availability, control of external equipment, coordination of multiple broadcasts, automated compilation and collection of billing data, and generation and presentation of combined media presentations of broadcast and locally-generated user specific content. ('81 case, Abstract; col. 3 line 29 to col. 5 line 27). The priority disclosure further discusses coordination and control of programming at several levels of the communications chain, including transmission stations, intermediate transmission stations, and receiver stations. Regarding the present application, the examiner's attention is directed to the '81 case, column 20, lines 16-68 for claim 56¹; column 9, line 31, column 10, line 14 through column 12, line 67, and column 19, line 30 through column 20, line 7 for claims 75 and 80²; and column 9, line 31, column 10, line 14 through column 12, line 67, and column 19, line 30 through column 20, line 68 for claim 84³;

Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.

Claims 75, 80 and 84 were objected to for a consecutive repetition of "at" in line 1 of each claim. As per the Applicants' request for amendment, the relevant recitation is

¹ see '87 specification, pp. 469-478.,

² see '87 specification, pp. 324-390, 447-457 and 19-28.

³ see '87 specification, pp. 324-390, 447-457, 19-28 and 469-478.

"A method of delivering a video presentation at at least one receiver station of a plurality of receiver stations." Applicants intend said repetition. To clarify the recitation, Applicants reiterate it as follows: A method of delivering a video presentation at *the location of* at least one receiver station of a plurality of receiver station. Applicants submit the foregoing clarifies the repetition of "at" as intended and, thus, respectfully request withdrawal of the relevant objections to claims 75, 80 and 84.

Applicants have amended claims 67, 75, 80 and 84 to eliminate the various informalities objected to. Applicants respectfully request withdrawal of the relevant objections.

Claims 56-92 remain active in this application. Certain claims have been amended in accordance with the examiner's specific rejections of claims 56-74 and 77-79 under 35 U.S.C. § 112, second paragraph, and to improve clarity. The examiner's comments on the claims are acknowledged and appreciated. No new matter is presented in the foregoing amendments. Approval and entry of the requested amendments are respectfully requested.

Claims 56-74 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,536,791 to Campbell *et al.* (Campbell).

It is the Applicants' position that the Campbell patent is not prior art. The Campbell reference claims priority to a continuation of Ser. No. 348,937 filed November 27, 1981, which is a continuation-in-part (CIP) of Ser. No. 135,987 filed March 31, 1980. The disclosure of the former (the CIP application) is not prior art since the filing date is after that of the pending application. Also, the examiner has not demonstrated that the

disclosure of the parent application, filed March 31, 1980, includes the matter that is applied against the present application to negate patentability under 35 U.S.C. 102(b). Applicants submit that since the chain of applications includes a continuation-in-part, the examiner may not apply the disclosure of the more recent patent while simultaneously relying on the filing date of the earlier, abandoned application that may not contain the disclosure relied upon to negate patentability in the present application. Assuming *arguendo* that Campbell is a valid reference, Applicants present the following arguments.

The pay-per-view premium programming feature of Campbell is said to disclose the claimed method. The printing of a message is equated to the step of displaying video that describes or promotes a transaction. Office Action, page 28, last paragraph, lines 4-6.

The pay-per-view premium programming feature of Campbell discloses that a message is printed on a television screen requiring that a subscriber key number be entered on a keyboard if the television channel selected is a premium channel that required additional billing. Campbell, col. 17, lines 54-58. When the key number is entered correctly, the converter requests the data control system at the head end to authorize reception of the channel. *Id.* at lines 58-61. The data control system then commands the converter to allow or disallow the selected program and retains billing information for the service as required. *Id.* at lines 61-64.

From the foregoing disclosure of Campbell, it is presumed that the examiner's "transaction" is the entering of the subscriber key number on the keyboard. The user

entering the key number on the keyboard is equated to the step of receiving a reply.
Office Action, page 28, last paragraph, lines 7-8.

Amended claim 56 recites the steps of selecting code or a datum that designates a transaction in response to a step of receiving a reply; and communicating the selected code or datum to a remote site. In Campbell, after the correct key number is entered on the keyboard, the converter requests the head end to authorize reception of the channel and the head end commands the converter to allow or disallow the selected program.

Neither the request for authorization nor the head end commanding of the converter anticipate the claimed step of selecting a code or a datum. To select is to pick out from among several; or to make a choice. *Webster's II New College Dictionary*, 1995. Neither requesting nor commanding nor retaining is equivalent to selecting. The pay-per-view premium programming feature of Campbell fails to disclose the picking out, choosing or selecting of code or a datum in response to the user entering the correct key number on the keyboard (examiner's step of receiving a reply). Accordingly, Campbell fails to anticipate the steps of selecting; communicating said selected code or datum; delivering at least one processor instruction in response to said step of communicating; delivering the transaction or an acknowledgment that designates the transaction on the basis of the at least one processor instruction from the step of delivering said at least one processor instruction.

To designate is to indicate, specify, or point out. *Id.* Assuming *arguendo* that the pay-per-view premium programming feature discloses the selection of code or a datum in response to the user entering the correct key number on the keyboard, Campbell fails

to disclose that the selected code or datum indicates, specifies, points out or designates the examiner's "transaction," which is presumed to be the entering of the subscriber key number on the keyboard. Accordingly, Campbell fails to disclose the steps of selecting; communicating; delivering said at least one processor instruction; and delivering the transaction or the acknowledgment.

Amended claim 56 recites the step of communicating said selected code or datum to a remote site. In anticipation of this step, the pay-per-view premium programming feature of Campbell is said to disclose "passing along appropriate transactional information for billing purposes." Office Action, page 29, lines 4-5. Actually, Campbell discloses that the data control system of the pay-per-view premium programming feature "*retains* billing information." Campbell, col. 17, lines 61-64, emphasis added. Campbell does not disclose that the billing information is communicated to a remote site. Consequently, Campbell fails to anticipate the steps of communicating; delivering at least one processor instruction in response to said step of communicating; delivering the transaction or an acknowledgment that designates the transaction on the basis of the at least one processor instruction from the step of delivering said at least one processor instruction.

Amended claim 56 recites the steps of displaying video that at least one of describes and promotes a transaction; and delivering one of said transaction and an acknowledgment that designates the transaction on the basis of at least one processor instruction. The processor instruction is delivered in response to communicating code

or a datum that designates said transaction and is selected in response to receiving a reply from a customer.

As before, it is presumed that the examiner's "transaction" is the entering of the subscriber key number on the keyboard, since, in Campbell, the message that is printed on the television screen requires that a subscriber key number be entered on a keyboard. Campbell fails to disclose that this transaction or an acknowledgment that designates this transaction is delivered in response to a processor instruction that is delivered in response to communicating code or a datum that (i) designates this transaction and (ii) was selected in response to the user entering the key number (examiner's step of receiving a reply). Campbell does disclose that the data control system commands the converter to allow or disallow the selected program, however, this commanding is clearly not the entering of the subscriber key number on the keyboard or an acknowledgment that designates the entering of the subscriber key number on the keyboard. The commanding merely commands the converter to allow or disallow the selected program. Furthermore, the command is in regard to a *program* while the message that is printed on the television screen is a result of the a premium *channel* being selected. Thus, the commanding performed by the control system is without regard to the message displayed on the television screen. Therefore, it cannot be said that Campbell discloses delivering a transaction or an acknowledgment that designates a transaction that was at least one of described and promoted via displayed video. Accordingly, Campbell fails to anticipate the steps of delivering one of said transaction and said acknowledgment.

Amended claim 56 recites the step of delivering at least one processor instruction. The claimed at least one processor instruction controls the interactive video apparatus, is the basis for the processor processing the customer reply and delivering the transaction or acknowledgment, and is delivered in response to communicating to a remote site the claimed code or a datum. Applicants submit that Campbell fails to disclose such a one processor instruction. Accordingly, Campbell fails to anticipate the steps of receiving; selecting; communicating; delivering said at least one processor instruction; and delivering one of said transaction and said acknowledgment.

Since Campbell fails to anticipate all that is recited in amended claim 56, Applicants respectfully request withdrawal of the relevant rejection.

Claims 57-74 are dependent upon amended claim 56. As discussed *supra*, Campbell fails to disclose every element of amended claim 56 and thus, *ipso facto*, fails to anticipate amended claims 57-74. Applicants respectfully request that the relevant rejections be withdrawn.

Claims 75-79 stand rejected under 35 U.S.C. § 102(b) as anticipated by Hedger, "Broadcast Telesoftware: Experience with ORACLE", 1980 (Hedger).

The present application claims priority under 35 U.S.C. § 120 to the '81 case, App. Ser. No. 06/317,510, filed November 3, 1981 and issued as U.S. Pat. No. 4,694,490. 35 U.S.C § 102(b) states that a person shall be entitled to a patent unless the invention was described in a printed publication in this or a foreign country, more than one year prior to the date of the application of patent in the United States. Applicants find that the only reference to date in Hedger is a copyright date of 1980. Since the printed

publication date of "1980" is not necessarily more than one year prior to Applicants' priority date of November 3, 1981, it has not been established that the printed publication of Hedger occurred more than one year prior to the Applicants' date of application. Accordingly, the rejection of claims 75-79 under 35 U.S.C. §102(b) is improper and Applicants respectfully request withdrawal of the relevant rejections. Assuming *arguendo* that Hedger is a valid reference, Applicants present the following arguments.

In Hedger, telesoftware is broadcast as machine-code for a microprocessor at a terminal. Hedger, section 3, page 419. The terminal has been equated to the claimed at least one receiver station. Office Action, pg. 32, lines 21-22. The telesoftware includes programs that are described in paragraphs 4.1-4.6. Presumably, the telesoftware and the programs have been equated to the claimed downloadable processor instructions.

In amended claim 75 the downloadable processor instructions instruct at least one receiver station to generate or output a specific portion of a video presentation. The video presentation includes a first video image and a second video image that overlays the first video image. The second video image contains at least one datum that at least one of completes and supplements the first video image.

Hedger fails to disclose a video presentation that includes an overlay of a second video image upon a first video image. Thus, it cannot be said that Hedger discloses the step of receiving downloadable processor instructions that instruct at least one receiver station to generate or output a specific portion of a video presentation that includes a first video image and a second video image that overlays the first video image. Thus,

Hedger fails to anticipate the steps of receiving at a transmitter station said downloadable processor instructions; transferring said downloadable processor instructions; receiving said at least one control signal; transferring said at least one control signal; and transmitting.

Amended claim 75 recites the step of receiving at least one control signal at the transmitter station. The control signal is operative at a receiver station to control one of (i) an execution of the downloadable processor instructions and (ii) a delivery of at least a portion of the video presentation. The control signal is transferred to a transmitter and transmitted in an information transmission that is comprised of the downloadable processor instructions and the control signal.

Hedger fails to disclose a control signal that anticipates the claimed at least one control signal. Assuming *arguendo* that Hedger discloses a control signal that is operative at a receiver station to control (i) an execution of the downloadable processor instructions or (ii) a delivery of at least a portion of the video presentation, Hedger fails to disclose that such an assumed control signal is transmitted in an information transmission that is comprised of the claimed downloadable processor instructions and the control signal. Thus, Hedger fails to anticipate the steps of receiving at least one control signal; transferring said at least one control signal; and transmitting.

In sum, Hedger fails to anticipate all that is recited in amended claim 75, and, thus, Applicants respectfully request withdrawal of the relevant rejection.

Claims 76-79 are dependent upon amended claim 75. As discussed *supra*, Hedger fails to disclose every element of amended claim 75 and thus, *ipso facto*, fails to

anticipate amended claims 76-79. Applicants respectfully request that the relevant rejections be withdrawn.

Claims 80-83 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,430,731 to Gimple *et al.* ("Gimple").

Amended claim 80 recites a method of delivering a video presentation at at least one receiver station of a plurality of receiver stations. The method includes the steps of receiving, at an origination transmitter station, video to be transmitted by a remote intermediate transmitter station and delivering said video to an origination transmitter. The video contains an instruct signal that instructs the at least one receiver station to at least one of (i) generate or output a specific portion of a video presentation and (ii) deliver data that is at least one of described and promoted in said video.

The subscriber terminal units 10 of Gimple have been equated to the claimed plurality of receiver stations. Office Action, page 33, line 20. The remote video data distribution module 8 ("RVDM") has been equated to the claimed remote intermediate transmitter station. *Id.* at page 34, lines 4-5. Column 3, lines 49-52 of Gimple have been cited as disclosing the claimed video that contains an instruct signal. Column 2, lines 32-49 of Gimple have been cited with regard to instruct and control signals.

At column 3, line 49-52, Gimple discloses that data is transmitted in packets of information, which includes destination address, instruction, data, parity bits, and termination bits. Column 2, lines 32-49 disclose that data signals are designated as address, data and control signals.

Applicants' claimed instruct signal is contained within a signal that contains video and the claimed instruct signal. Gimple fails to disclose that any of the data signals, information, destination address, instruction, parity bits, and termination bits (hereafter, "data signals") are contained within a signal that contains video and the data signals. Gimple discloses that the data signals are in the DS-1 format. Gimple, col. 3, lines 45-46. The DS-1 format is not disclosed as being contained within or embedded in video. Figure 1A illustrates that the incoming and outgoing data signals are transmitted on 12 megahertz and 6 megahertz carriers, respectively. Gimple, col. 3, lines 52-57. In contrast, television channels and FM broadcasts are transmitted from 50 to 300 megahertz. Gimple, col. 3, lines 20-26 and Fig. 1A. Clearly, Gimple does not disclose that the 12 megahertz and 6 megahertz carriers are contained within a signal that also contains 50-300 megahertz television channels. Rather, Gimple discloses that the incoming and outgoing carrier signals are carried by a subscriber drop that *also* carries CATV television signals. Gimple, col. 28, lines 20-24. Thus, the data signals are in addition to television signal; not contained in a single signal that contains video and the data signals. Thus, the data signals fail to anticipate the claimed instruct signal. Accordingly, Gimple fails to anticipate the steps of receiving video that contains the claimed instruct signal; delivering said video; receiving at least one control signal that controls the communication of at least one of said video and said instruct signal; and transmitting said at least one control signal and, thus, Applicants respectfully request withdrawal of the relevant rejection.

To instruct is to give orders to; to direct. *Webster's II New College Dictionary*, 1995. Assuming *arguendo* that Gimple discloses that the data signals are contained within video, Gimple fails to disclose that the data signals direct, give orders to, or instruct at least one of the subscriber terminal units 10 to generate or output a specific portion of a video presentation or deliver data that is described or promoted in the assumed video. Accordingly, Gimple fails to anticipate the steps of receiving video, delivering, receiving at least one control signal, and transmitting.

In sum, Applicants submit that Gimple fails to anticipate all that is recited in amended claim 30 and, thus, respectfully request withdrawal of the relevant rejection.

Claim 82 is dependent upon amended claim 80. As discussed *supra*, Gimple fails to disclose every element of amended claim 80 and thus, *ipso facto*, fails to anticipate claim 82. Applicants respectfully request that the relevant rejection be withdrawn.

Claims 81 and 83 stand rejected under 35 U.S.C. § 103 as obvious over Gimple.

Applicants repeat their exposition, *supra*, of the various failings of Gimple to anticipate claim 80. According to these failings, Gimple as modified likewise fails to anticipate claims 81 and 83. Applicants respectfully request withdrawal of the relevant rejections.

Claims 84-86 stand rejected under 35 U.S.C. § 103 as unpatentable over Gimple in view of British Patent Specification 1,370,535 to Millar *et al.* ("Millar").

Amended claim 84 recites the step of receiving at least one instruct signal at a transmitter station. The at least one instruct signal instructs at least one receiver station

to deliver a combined presentation or a sequential presentation of video and at least one of (i) at least one receiver specific datum and (ii) at least one datum that is at least one of described and promoted in said video.

In anticipation of "the delivery of a combined presentation of video and one or more data described in said video," attention is drawn to Gimple's display of alphanumerics at the bottom of a television screen. Office Action , page 36, lines 18-20 and page 37, lines 4-5. The examiner states that Gimple anticipates all that is recited in claim 84 but for the alphanumerics being "related to the video." Office Action, page 36, lines 15-21. The proposed modification of Gimple in view of Millar entails displaying "sub-titles as suggested by Millar on the TV screen of the subscriber in Gimple since it would enable deaf viewer to better understand the video." Office Action, page 37, lines 1-4.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

The system of Gimple is disclosed as providing means for displaying alphanumerics at a video monitor. Gimple, col. 22, lines 24-26. Gimple discloses that a keyboard 581 operates similarly to key pad 573, by which services are requested and keys are depressed. Gimple, col. 22, lines 21-22. Key pad 573 includes a button that is pressed by a subscriber to input data. Gimple, col. 21, lines 32-35. The data is sent to a microprocessor that sends a message back to the key pad to illuminate a light emitting diode and indicate the depressed button. Gimple, col. 21, lines 35-41. With regard to keyboard 581, Gimple describes that a VRAM in the RVDM receives the signals and causes the display of the key indication alphanumerics. The video signals are received at the subscriber terminal unit 10 and applied to a video monitor. Gimple, col. 22, lines 26-29. Upon the line of alphanumerics in the video display being correct for the user, a control key is depressed on keyboard 581. Gimple, col. 22, lines 30-32. Thus, a user presses keys on a keyboard and alphanumerics that indicate the keys depressed are displayed on a video monitor. If the key indicating alphanumerics are correct, the user presses keys on the keyboard to indicate so.

Gimple does not disclose that the alphanumerics are described or promoted by a video. Gimple does not disclose that the alphanumerics are presented in combination or in sequence with video. Gimple does not disclose that the alphanumerics are delivered by the subscriber terminal unit in a combined or sequential presentation with video. Gimple fails to disclose any of the data signals, information, destination address, instruction, parity bits, and termination bits (examiner's "at least one instruct signal") instruct a subscriber terminal unit (examiner's "at least one receiver station") to deliver

a combined presentation or a sequential presentation of video and at least one of (i) at least one receiver specific datum and (ii) at least one datum.

In view of the foregoing, Applicants traverse the examiner's characterization of Gimple as anticipating all that is recited in claim 84 but for the alphanumerics being "related to the video." Accordingly, the proposed modification of Gimple fails to anticipate all that is recited in claim 84 and, thus, Applicants respectfully request withdrawal of the relevant rejection.

Furthermore, the alphanumerics are not disclosed as being displayed or delivered with any video and, thus, Applicants question what "the video" is at Office Action, page 36, line 21.

Millar discloses the display of alphanumeric information, such as captions, with a video picture. The captions may be sub-titles.

Millar fails to disclose at least one instruct signal that instructs at least one receiver station to deliver a combined presentation or a sequential presentation of video and at least one of (i) at least one receiver specific datum and (ii) at least one datum that is at least one of described and promoted in said video.

Since not one of Millar, Gimple, and Millar and Gimple combined teach or suggest a signal that anticipates the claimed at least one instruct signal, the examiner has failed to establish a *prima facie* case of obviousness by meeting all of the three basic criteria. Accordingly, Applicants respectfully request withdrawal of the relevant rejection.

Applicants submit that, in Gimple, Millar, and in the knowledge generally available to one of ordinary skill in the art, there is no suggestion or motivation to display the sub-titles of Millar on the television screen of Gimple for the reason set forth by the examiner (to enable deaf viewers to better understand video), because the deaf do not have difficulty in understanding video, as they are hearing impaired, not seeing impaired. Therefore, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to display the sub-titles of Millar on the TV screen of Gimple and, thus, Applicants respectfully request withdrawal of the relevant rejection.

Furthermore, in Gimple, the alphanumerics are displayed in representation of the buttons that are pressed on keyboard 581. A deaf viewer would have no trouble perceiving such a display. Adding a subtitle or caption to the alphanumeric display of Gimple would be entirely superfluous and redundant since the alphanumeric display is already perceptible by the deaf. Thus, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to display the sub-titles of Millar on the TV screen of Gimple. Accordingly, Applicants respectfully request withdrawal of the relevant rejection.

Assume *arguendo* that “the video” found in the examiner’s rejection is some video from the CATV television signals (Gimple, col. 28, lines 23-24). Applicants note that the alphanumerics of Gimple are not displayed in association with any video from the CATV television signals. Thus, “display[ing] sub-titles [of] . . . Millar on the TV screen of the subscriber in Gimple [to] . . . enable deaf viewers to better understand the

video" would have nothing to do with the display of the alphanumerics, but would involve a wholesale import of the system of Millar into the system of Gimple. Since Millar and Gimple each fail to disclose an instruct signal that (a) is received at a transmitter station; (b) instructs at least one receiver station to deliver a combined or sequential presentation of video and at least one of (i) at least one receiver specific datum and (ii) at least one datum that is at least one of described and promoted in said video; (c) is transferred from said transmitter station to a transmitter; and (d) is transmitted from said transmitter station to said at least one receiver station, all of the prior art references, solely and in combination, fail to teach or suggest a signal that anticipates the claimed at least one instruct signal. Therefore, the examiner has failed to establish a *prima facie* case of obviousness and Applicants respectfully request withdrawal of the relevant rejection.

Claims 85 and 86 are dependent upon amended claim 84. As discussed *supra*, Gimple in view of Millar fails to disclose every element of amended claim 84 and thus, *ipso facto*, fails to anticipate amended claims 85 and 86. Applicants respectfully request that the relevant rejections be withdrawn.

Claims 75-79 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zaboklicki (DE 2904981) ("Zaboklicki) in view of "A Public Broadcaster's View of Teletext in the United States" by Hartford Gunn ("Gunn").

In amended claim 75 the downloadable processor instructions instruct at least one receiver station to generate or output a specific portion of a video presentation. The video presentation includes a first video image and a second video image that overlays

the first video image. The second video image contains at least one datum that at least one of completes and supplements the first video image.

In Zaboklicki, neither the transmitted digital processing program nor any instruction that is received at a transmitter station and transferred to a transmitter is disclosed as instructing Zaboklicki's receiver side to generate or output a specific portion of a video presentation that includes a first video image and a second video image, the second video image overlaying the first video image and containing a datum that completes or supplements the first video image. Consequently, Zaboklicki as modified fails to anticipate the claimed downloadable processor instructions and, thus, the steps of receiving at a transmitter station said downloadable processor instructions; transferring said downloadable processor instructions; receiving said at least one control signal; transferring said at least one control signal; and transmitting.

Modifying Zaboklicki in view of Gunn is relied upon to anticipate the "one or more control signals" recited prior to this amendment. As amended, claim 75 recites the step of receiving at least one control signal at a transmitter station. The at least one control signal is operative at a receiver station to control one of (i) an execution of said downloadable processor instructions and (ii) a delivery of at least a portion of said video presentation.

Zaboklicki fails to disclose a signal that anticipates the claimed at least one control signal.

Assuming *arguendo* that Zaboklicki does disclose the claimed at least one control signal, Zaboklicki does not disclose such a signal is transferred to a transmitter and

transmitted in an information transmission with the claimed downloadable processor instructions, as claimed.

Gunn also fails to disclose a signal that is operative at a receiver station to control one of (i) an execution of downloadable processor instructions that meet the claimed limitations and (ii) a delivery of at least a portion of a video presentation that includes a first image and a second image that is overlaid upon the first image and completes or supplements the first image. In this regard, since none of Zaboklicki, Gunn and Zaboklicki and Gunn combined anticipate the claimed at least one control signal, the examiner has failed to set forth a *prima facie* case of obviousness. Accordingly, Applicants respectfully request withdrawal of the relevant rejection.

Assuming *arguendo* that Gunn does disclose the claimed at least one control signal, Gunn does not disclose that such a signal is transferred to a transmitter and transmitted in an information transmission with the claimed downloadable processor instructions. In this regard, since none of Zaboklicki, Gunn, and Zaboklicki and Gunn combined teach or suggest a signal that anticipates the claimed at least one control signal, the examiner has failed to establish a *prima facie* case of obviousness.

In view of the foregoing, Applicants submit that Zaboklicki as modified fails to anticipate all that is recited in amended claim 75. Accordingly, Applicants respectfully request withdrawal of the relevant rejection.

Claims 76-79 are dependent upon amended claim 75. As discussed *supra*, Zaboklicki in view of Gunn fails to disclose every element of amended claim 75 and

thus, *ipso facto*, fails to anticipate amended claims 76-79. Applicants respectfully request that the relevant rejections be withdrawn.

As to the rejection of Applicants' claims under non-statutory, non-obvious type double patenting, Applicants strongly traverse the Examiner's double patenting rejection on three separate grounds which are set forth in the reply brief of Serial No. 08/113,329 (Atty. Docket No. 05634.008), incorporated herein by reference. For the sake of brevity, these arguments will not be set forth herein; the Examiner is respectfully directed to the above-mentioned reply brief.

The claims in the present application are distinct from the claims in the Harvey patents. As previously mentioned, the Office Action states that the independent and distinct standard was the main factor in the Schneller court's determination that the double patenting rejection should be affirmed. The Office Action has misinterpreted this phrase. This phrase means independent 'or' distinct. MPEP (6th ed.) § 802.01. The MPEP defines independent as meaning "that there is no disclosed relationship between the two or more subjects disclosed" and that they are not connected. The MPEP defines the term distinct as meaning that "two or more subjects disclosed are related . . . but are capable of separate manufacture, use, or sale as claimed" Two or more subjects cannot then be unrelated, independent, and also related, and thus distinct. Analyzing the PTO's cited representative claims referenced in the Office Action, the claims of the present application are clearly distinct from the claims in the patents and therefore the claims in the present application are patentable. Although not required, applicants will

analyze the claims of the present application with respect to the designated representative claims of Harvey U.S. Patents 4,694,490 and 4,704,725.

Claim 84 of the present application is distinct from the first representative claim, claim 7 of U.S. Patent 4,694,490

Patent 4,694,490, claim 7 claims a method of communicating television program material, said material including a video signal containing a television program and an instruct-to-overlay signal, to multiple receiver stations. The video signal is received and the instruct-to-overlay signal detected and processed by a computer. The computer generates and transmits its overlay video signals to a television receiver which presents a combined display of the television program and overlay video signals, said display being specific to a particular user.

Present application claim 84, as amended, relates to a method of delivering a video presentation at a receiver station of a plurality of receiver stations. The method includes receiving video and an instruct signal at a transmitter station. The instruct signal instructs the receiver station to deliver a combined or sequential presentation of the video with a receiver specific datum or a datum that is described or promoted in the video. The video and instruct signal are delivered to a transmitter and transmitted to the receiver station.

Patent claim 7 does not cover present application claim 84. Patent claim 7 relates to instruct-to-overlay signals that are processed by a computer and received by a television receiver which presents a combined display of the instruct-to-overlay signal and a television program. Application claim 84 relates to an instruct signal that

instructs the delivery of a datum and video presentation. The two claims are capable of separate manufacture, use, and sale as claimed and, as such, these two inventions are distinct.

U.S. patent 4,694,490, claim 7	Present application, claim 84 (as amended)
<p>In a method of communicating television program material to a multiplicity of receiver stations each of which includes a television receiver and computer, the computers being adapted to generate and transmit overlay video signals, to their associated television receivers, said overlay signals causing the display of user specific information related to said program material, and with at least some of said computers being programmed to process overlay modification control signals so as to modify the overlay video signals transmitted to their associated receivers, each of said computers being programmed to accommodate a specific user application, and wherein a video signal containing a television program signal and an instruct-to-overlay signal are transmitted to said receiver stations, the steps of:</p> <p>receiving said video signal at a plurality of receiver stations and displaying said program material on the video receivers of selected ones of said plurality of receiver stations</p> <p>detecting the presence of said instruct-to-overlay signal at said selected receiver stations at a time when the corresponding overlay is not being displayed, and</p> <p>coupling said instruct-to-overlay signal to the computers at said selected receiver stations, and</p>	<p>A method of delivering a video presentation at at least one receiver station of a plurality of receiver stations each of which includes a receiver, a signal detector, a processor, and an output device, and is adapted to detect the presence of at least one signal, said method comprising the steps of:</p> <ol style="list-style-type: none"> (1) receiving video at a transmitter station; (2) delivering said video to a transmitter; (3) receiving at least one instruct signal at said transmitter station, said at least one instruct signal instructs said at least one receiver station to deliver one of a combined presentation and a sequential presentation of said video and at least one of (i) at least one receiver specific datum and (ii) at least one datum that is at least one of described and promoted in said video; (4) transferring said at least one instruct signal from said transmitter station to said transmitter; and (5) transmitting said video and said at least one instruct signal from said transmitter station to said at least one receiver station.

causing the computers at said selected receiver stations to generate and transmit their overlay video signals to their associated television receivers in response to said instruct-to-overlay signal, thereby to present a combined display at the selected receiver stations consisting of the television program and the related computer generated overlay, the overlays displayed at a multiplicity of said receiver stations being different, with each display specific to a specific user.

Claim 84 of the present application is distinct from the second representative claim, claim 3 of U.S. Patent 4,704,725

Patent 4,704,725, claim 3 claims a method of communicating output signals comprising data and user specific signals at a multiplicity of receiver stations from computers to output devices. At least some of the computers can modify the user specific signals by processing modification control signals. The computers communicate the data and user specific signals in response to a received and detected instruct-to-transmit signal.

Present application claim 84, as amended, relates to a method of delivering a video presentation at a receiver station of a plurality of receiver stations. The method includes receiving video and an instruct signal at a transmitter station. The instruct signal instructs the receiver station to deliver a combined or sequential presentation of the video with a receiver specific datum or a datum that is described or promoted in the video. The video and instruct signal are delivered to a transmitter and transmitted to the receiver station.

Patent claim 3 does not cover present application claim 84. Patent claim 3 relates to the communication of user specific signals. Application claim 84 relates to an instruct signal that instructs the delivery of a datum and video presentation. The two claims are capable of separate manufacture, use, and sale as claimed and, as such, these two inventions are distinct.

U.S. patent 4,704,725, claim 3	Present application, claim 84 (as amended)
<p>A method of communicating data to a multiplicity of receiver stations each of which includes a computer adapted to generate and transmit user specific signals to one or more associated output devices, with at least some of said computers being programmed to process modification control signals so as to modify the user specific signals transmitted to their associated output devices, each of said computers being programmed to accommodate a special user application, comprising the steps of:</p> <p>transmitting an instruct-to-transmit signal to said computers at a time when the corresponding user specific information is not being transmitted to an output device;</p> <p>detecting the presence of said instruct-to-transmit signal at selected receiver stations and coupling said instruct-to-transmit signal to the computers associated with said selected stations, and</p> <p>causing said last named computers to generate and transmit their user specific signals to their associated output devices in response to said instruct-to-transmit signal, thereby to transmit to the selected output devices an output signal comprising said data and said related user specific signals, the output signals at a</p>	<p>A method of delivering a video presentation at at least one receiver station of a plurality of receiver stations each of which includes a receiver, a signal detector, a processor, and an output device, and is adapted to detect the presence of at least one signal, said method comprising the steps of:</p> <ol style="list-style-type: none"> (1) receiving video at a transmitter station; (2) delivering said video to a transmitter; (3) receiving at least one instruct signal at said transmitter station, said at least one instruct signal instructs said at least one receiver station to deliver one of a combined presentation and a sequential presentation of said video and at least one of (i) at least one receiver specific datum and (ii) at least one datum that is at least one of described and promoted in said video; (4) transferring said at least one instruct signal from said transmitter station to said transmitter; and (5) transmitting said video and said at least one instruct signal from said transmitter station to said at least one receiver station.

multiplicity of said output devices being different, with each output signal specific to a specific user.

Claim 84 of the present application is distinct from the third representative claim, claim 24 of U.S. Patent 4,965,825

Patent 4,965,825, claim 24 claims a method of generating user specific output information at a multiplicity of receiver stations. Each receiver station is programmed with a special user application and has a computer adapted to generate user specific output information. Each receiver station has an output device to which its computer transmits a user specific signal. At a time when the user specific output information does not exist, an instruct-to-generate signal is transmitted to the receiver stations. In response to the instruct-to-generate signal, the computers generate and transmit to the output devices the user specific output information in user specific signals which are different, "with each output signal specific to a specific user".

Present application claim 84, as amended, relates to a method of delivering a video presentation at a receiver station of a plurality of receiver stations. The method includes receiving video and an instruct signal at a transmitter station. The instruct signal instructs the receiver station to deliver a combined or sequential presentation of the video with a receiver specific datum or a datum that is described or promoted in the video. The video and instruct signal are delivered to a transmitter and transmitted to the receiver station.

Patent claim 24 does not cover present application claim 84. Claim 24 relates to user specific signals sent from the receiver station to an output device. Application claim 84 relates to an instruct signal that instructs the delivery of a datum and video presentation. The two claims are capable of separate manufacture, use, and sale as claimed and, as such, these two inventions are distinct.

U.S. patent 4,965,825, claim 24	Present application, claim 84 (as amended)
<p>In a method of generating computer output at a multiplicity of receiver stations each of which includes a computer adapted to generate and transmit user specific output information content and user specific signals to one or more associated output devices, with at least one or more associated output devices, with at least some of said computers being programmed to process modification control signals so as to modify said computers' method of processing data and generating output information content, each of said computers, being programmed to accommodate a special user application, the steps of: transmitting an instruct-to-generate signal to said computers at a time when corresponding user specific output information content does not exist, and causing said last named computers to generate their user specific output information content in response to said instruct-to-generate signal, thereby to transmit to each of their associated output devices an output information content and the user specific signal of its associated computer, the output signals at a multiplicity of said output devices being different, with each output signal specific</p>	<p>A method of delivering a video presentation at at least one receiver station of a plurality of receiver stations each of which includes a receiver, a signal detector, a processor, and an output device, and is adapted to detect the presence of at least one signal, said method comprising the steps of:</p> <ol style="list-style-type: none"> (1) receiving video at a transmitter station; (2) delivering said video to a transmitter; (3) receiving at least one instruct signal at said transmitter station, said at least one instruct signal instructs said at least one receiver station to deliver one of a combined presentation and a sequential presentation of said video and at least one of (i) at least one receiver specific datum and (ii) at least one datum that is at least one of described and promoted in said video; (4) transferring said at least one instruct signal from said transmitter station to said transmitter; and (5) transmitting said video and said at least one instruct signal from said transmitter station to said at least one receiver station.

to a specific user.

Claim 84 of the present application is distinct from the fourth representative claim, claim 15 of U.S. Patent 5,109,414

Patent 5,109,414, claim 15 claims a signal processing system which receives data from a data source and outputs the data to a matrix switch and a detector, control signals are detected within the received data and stored for further processing, and a processor controls the directing functions of (1) the matrix switch which receives the data as input and can direct selected portions of the data to a data transmission means and (2) the device which stores and transfers the control signals to the processor.

Present application claim 84, as amended, relates to a method of delivering a video presentation at a receiver station of a plurality of receiver stations. The method includes receiving video and an instruct signal at a transmitter station. The instruct signal instructs the receiver station to deliver a combined or sequential presentation of the video with a receiver specific datum or a datum that is described or promoted in the video. The video and instruct signal are delivered to a transmitter and transmitted to the receiver station.

Patent claim 15 does not cover present application claim 84. Patent claim 15 relates to a data system that receives and processes data from a data source and includes a processor that controls the functions of a matrix switch and a storage device. Application claim 84 relates to an instruct signal that instructs the delivery of a datum and video presentation. The two claims are capable of separate manufacture, use, and sale as claimed and, as such, these two inventions are distinct.

U.S. patent 5,109,414, claim 15	Present application, claim 84 (Amended)
<p>In a signal processing system,</p> <p> a receiver/distribution means for receiving data from a data source and for outputting said data to a matrix switch means and a control signal detector means,</p> <p> a matrix switch means for receiving said data from said receiver/distributor means and for directing selected portions of said received data to a data transmission means,</p> <p> a control signal detector means for detecting control signals respecting said data and transferring said control signals to a storage/transfer means, said control signal means being configured to detect said control signals at a predetermined location within said data,</p> <p> a storage/transfer means for receiving and storing said control signals and for transferring at least a portion of said control signals to a processor means for further processing, and</p> <p> a processor means for controlling the directing functions of said matrix switch means and the transfer functions of said storage/transfer means based on instructions contained in said control signals.</p>	<p>A method of delivering a video presentation at at least one receiver station of a plurality of receiver stations each of which includes a receiver, a signal detector, a processor, and an output device, and is adapted to detect the presence of at least one signal, said method comprising the steps of:</p> <ol style="list-style-type: none"> (1) receiving video at a transmitter station; (2) delivering said video to a transmitter; (3) receiving at least one instruct signal at said transmitter station, said at least one instruct signal instructs said at least one receiver station to deliver one of a combined presentation and a sequential presentation of said video and at least one of (i) at least one receiver specific datum and (ii) at least one datum that is at least one of described and promoted in said video; (4) transferring said at least one instruct signal from said transmitter station to said transmitter; and (5) transmitting said video and said at least one instruct signal from said transmitter station to said at least one receiver station.

The Office Action states that "determination of a possible non-statutory double patenting rejection obvious-type in each of the related 327 applications over each other will be deferred until a later time." (Office Action, p. 12 at lines 3-6). Applicants submit that the Examiner and the PTO cannot defer further rejections to a later time. Every ground of rejection should be made in examiner's first Office Action. Title 37 of the CFR states that "[o]n taking up an application for examination . . . the examiner shall

make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect to both compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.” 37 CFR § 1.104(a). The MPEP states “[t]he examiner’s action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before action is made.” MPEP § 707.07, quoting 37 CFR § 1.105. Finally, “[p]iecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available . . . Where a major technical rejection is proper, it should be stated with full development of reasons rather than by mere conclusion coupled with some stereotyped expression.” MPEP §707.07(g). Applicants submit that the Examiner has a duty to give each application a complete examination, that rejections be made with specificity, and that deferred rejections are not allowed. For these reasons, Applicants likewise traverse the rejection based on the “judicially created doctrine of double patenting over the claims of copending U.S. application 08/113,329 and the following [list of all applicants copending applications].” Applicants submit that this rejection, even if appropriately made with specificity, should be a provisional double patenting rejection. Applicants respectfully request that this rejection be withdrawn.

As to the paragraph numbered 3, Applicants acknowledge their duty to maintain a line of patentable demarcation between related applications. Assuming *arguendo* that substantially duplicate claims exist, the Applicants intend to make a good faith effort to alert the PTO of any instances in which the PTO treats such claims inconsistently.

As to the paragraph numbered 4, Applicants acknowledge and appreciate the examiner's concern over the use of alternative claim language. Applicants believe that the disclosure supports every possible embodiment or permutation that can be created using said language. During the prosecution of this application, Applicants intend to ensure that the disclosure supports each possible embodiment as claimed using alternative claims.

As to the paragraph related to the multiplicity rejection in parent file 07/096,096, Applicants submit that the PTO gave a multiplicity rejection in this case and limited Applicants to twenty-five claims. Roughly one hundred claims had been originally filed. There was no substantive review of any of the other claims outside of the twenty five. Applicants were not permitted to submit additional claims although a request was made. The disclosure of Applicants address too many subject areas to be adequately covered by a small number of claims. Applicant submit that "nexus" analysis is not required by Applicants.

Applicants acknowledge and appreciate the interviews provided by the PTO. Applicants also appreciate the detailed description of the interviews provided in the Office Action. The Office Action states that "the Group would like to have a complete grouping of applications in a manner that was submitted earlier for only a portion of

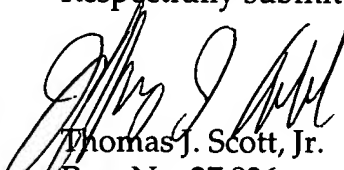
the total filings." Applicants note that based on the Office Actions received thus far, the PTO does not appear to be following the groupings applicants submitted previously. The order of examination of applicants' applications do not seem to have any correspondence to the groupings previously submitted. Applicants, therefore, will not supply further groupings. Applicants will, however, gladly supply further groupings if requested by the PTO for the purpose of following these groupings. Mr. Groody has confirmed in a telephone conversation between Mr. Groody and Mr. Scott that no more groupings need be sent.

In the interest of maintaining a clear record, Applicants respectfully traverse the Office Action's interview summary statement that an offer was made to terminally disclaim the present application with the '81 or '87 patents. Rather, applicants respectfully submit that their offer was to disclaim a block of copending applications against one another, provided their issue date was in close enough proximity so as not to result in unnecessarily great losses in patent term duration.

In accordance with the foregoing it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, that all pending claims patentably distinguish over the prior art, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for telephone interview to discuss resolution of such informalities.

Respectfully submitted,


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for

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